

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of

Alexandra Keene

Date: March 15, 2001

Serial No. : TBA
Filed : Concurrently
For : SYSTEM AND METHOD FOR CHECK EXCEPTION
ITEM NOTIFICATION

Box Patent Application
Asst. Commissioner of Patents
Washington, D.C. 20231

DECLARATION OF STEVEN S. RUBIN
IN SUPPORT OF PETITION TO MAKE SPECIAL

Steven S. Rubin declares:

1. I am registered to practice before the U.S. Patent and Trademark Office, Registration No. 43,063, and am one of the individuals who is empowered to act in the above application.
2. My declaration is made in support of the Applicant's Petition to Make Special the present application pursuant to 37 C.F.R. § 1.102 and MPEP 708.02 VIII.
3. The present application is directed toward an improved system and method for notifying a client of an exception item. A payor writes a check to a payee. The payee presents the check to the payee's bank. The payee's bank, in turn, presents that check to the payor's bank. Some payor banks provide a check exception item processing service in which the bank compares checks presented by payee banks to a list of checks written by the payor. If any checks do not match, an exception item is created. The system and method of the invention creates a web file and corresponding unique uniform

resources locator ("URL") for each payor client for the exception items. The URL is sent to the client via an electronic mail so that client may access the web page associated with the URL and quickly authorize or decline payment for the exception item.

4. Submitted with the present petition is an Information Disclosure Statement listing at least each of the references cited herein along with copies of those references.

5. I commissioned a search of pertinent prior art by engaging the patent search firm of Lacasse & Associates, 2001 Jefferson Davis Highway, Suite 806, Arlington, Virginia 22202. A manual search in the public search room of the U.S. Patent and Trademark Office was performed among the references classified in at least Class 235, subclasses 375 and 379; and Class 705, subclasses 27, 30, 35, 38, 39, 40, 42, 44, 45 and 75. Computer searching using, for example, using key words in the U.S. Patent and Trademark Office Automated Patent System was performed to augment the manual search.

6. Of the references cited in the above identified applications or located during the search described above, the following are deemed the most relevant to the present application.

U.S. Patent 5,373,550 to Campbell et al. shows a system for transferring an image of a check from one banking institution to another to facilitate and expedite payment of the check. The system shown in Campbell et al. does not provide exception item notification at all but merely sends an image of a presented check to a payor bank quickly. The payor bank is then required to determine whether the presented check corresponds to a check issued by the payor bank. There no disclosure for how exception clients are notified of exception items by the payor bank. Nor is there disclosure for the use of an electronic mail to provide notification of such exception items.

U.S. Patent 5,691,524 to Josephson shows a system for expediting the flow of data relating to checks presented between partner banks. Although exception

items are determined, the focus is on how information relating to such items may be conveyed between a payor bank and a payee bank. There is no disclosure for how clients are notified of such exception items by the payor bank. Nor is there disclosure for e-mailing a notification of an exception item.

U.S. patent 5,819,236 to Josephson shows a system where a restricted account file is received by an intermediary entity from participating financial institutions. The intermediary entity matches presented checks with the restricted account file to determine whether the presented checks should be cashed. Again, there is no disclosure relating to notifying clients of a payor bank of exception items via e-mail.

U.S. Patent 5,848,400 to Chang shows a system for quickly settling transactions between financial institutions. There is no disclosure for notifying a client of the financial institution of an exception item.

U.S. Patent 5,895,455 to Bellinger et al. relates to a system for processing, imaging, and cataloging a large amount of issued checks. These images can be used to detect an exception item. Further, the images themselves may be sent to a client electronically. However, there is no disclosure for sending a notice regarding such an exception item to a client of the payor bank. Nor is there disclosure for notifying a client of exception information with an e-mail.

U.S. Patent 5,940,844 to Cahill et al. discusses another system for processing, imaging, and cataloging a large amount of issued checks. These images can be made available to a user through a network. The system does not determine exception items.

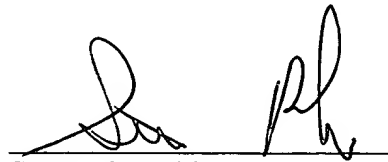
7. The prior art, taken alone or in combination, does not disclose the unique combination of elements recited in the claims of the present application. Specifically, none of the references, alone or in combination, disclose or suggest determining exception items and then notifying clients of a payor bank of those exception items via an

electronic mail as is explicitly required by independent claims 1, 10, 11, 18, 19 and 21 of the present application. Nor does the prior art disclose or suggest an electronic mail including information relating to an exception item as is required by independent claim 23 of the present invention.

8. Based upon the foregoing observations about the prior art, it is my opinion that the claims in the present application are allowable over the prior art.

9. I further declare that all statements made herein of my own knowledge are true, except for those statements made on information and belief, which are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this declaration, this application and any patent resulting therefrom.

Dated: March 15, 2001

 43,063
Steven S. Rubin

MJS:SSR:sak

Enc.: References
Form PTO-1449

As a below named inventor, I hereby declare that: my residence, post office address and citizenship are as stated below next to my name; that I verily believe that I am the original, first and sole inventor (if only one name is listed below) or a joint inventor (if plural inventors are named) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

SYSTEM AND METHOD FOR CHECK EXCEPTION ITEM NOTIFICATION

the specification of which is attached hereto, unless the following box is checked:

was filed on _____ as United States patent Application Number or PCT International patent application number _____ and was amended on _____ (if any).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose all information known to be material to patentability in accordance with Title 37, Code of Federal Regulations, ' 1.56.

I hereby claim priority benefits under Title 35, United States Code ' 119 of any foreign application(s) for patent or inventor's certificate or United States provisional application(s) listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign or Provisional Application(s)

COUNTRY	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. 119
U.S.A.	60/190,176	17-03-2000	YES <input checked="" type="checkbox"/> NO
			YES <input type="checkbox"/> NO
			YES <input type="checkbox"/> NO

I hereby claim the benefit under Title 35, United States Code, ' 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, ' 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, ' 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

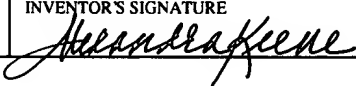
UNITED STATES APPLICATION NUMBER	DATE OF FILING (day, month, year)	STATUS (patented, pending, abandoned)

I hereby appoint customer no. 2352 OSTROLENK, FABER, GERB & SOFFEN, LLP, and the members of the firm, Samuel H. Weiner - Reg. No. 18,510; Jerome M. Berliner - Reg. No. 18,653; Robert C. Faber - Reg. No. 24,322; Edward A. Meilman - Reg. No. 24,735; Steven I. Weisburd - Reg. No. 27,409; Max Moskowitz - Reg. No. 30,576; Stephen A. Soffen - Reg. No. 31,063; James A. Finder - Reg. No. 30,173; William O. Gray, III - Reg. No. 30,944; Louis C. Dujmich - Reg. No. 30,625; Douglas A. Miro - Reg. No. 31,643, and Michael J. Scheer - Reg. No. 34,425, as attorneys with full power of substitution and revocation to prosecute this application, to transact all business in the Patent & Trademark Office connected therewith and to receive all correspondence.

SEND CORRESPONDENCE TO: OSTROLENK, FABER, GERB & SOFFEN, LLP
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

FULL NAME OF SOLE OR FIRST INVENTOR Alexandra Keene	INVENTOR'S SIGNATURE 	DATE April 8, 2001
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FULL NAME OF SECOND JOINT INVENTOR (IF ANY)	INVENTOR'S SIGNATURE	DATE
RESIDENCE (City and either State or Foreign Country)	COUNTRY OF CITIZENSHIP	
POST OFFICE ADDRESS		